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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/833,258   | 04/12/2001  | Carlos De La Huerga  | 250591.90295        | 3649             |
| 26710  | 7590        | 05/06/2005           | EXAMINER            |                  |
| QUARLES & BRADY LLP<br>411 E. WISCONSIN AVENUE<br>SUITE 2040<br>MILWAUKEE, WI 53202-4497 |             |                      | PHAN, THANH S       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2841                |                  |

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/833,258

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Thanh S. Phan

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) 35-158 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election of claims 1-34 in the reply filed on 01/06/05 is acknowledged. Applicant's remarks referencing to figure 5 is one embodiment of the printer of figure 2. This is not found persuasive as page 37 of the specification clearly disclosed figure 5 as the second embodiment of the compartment. Also, figure 5 does not show a printer. Nevertheless, examiner acknowledges that figures 2, 5, 7 as various embodiments of the container/compartment and figures 4, 6, 8 and 11 are embodiments of the printer/writer, figures 9 and 10 are embodiments of the system and 18 and 19 are embodiments of the label. Claims 1-34 are examined. Claims 35-163 are withdrawn from consideration. Restriction is hereby made final.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 16, 21, 26 and 28-34 rejected under 35 U.S.C. 102(b) as being anticipated by Liff et al. [US 5,713,485].

Regarding claims 1, 4, 26, 30, 31 Liff et al. disclose an apparatus [figure 1] comprising a reader [scanner 40 and/or 41] for reading each descriptor [bar code 98]; a writer [printer 54] for writing data to enhanced devices [label 58]; and a processor [computer 48] linked to the reader [through interface 64].

Regarding claim 2, Liff et al. discloses wherein the apparatus including a database [storage information related to a user such as name, medication etc] correlating descriptors with associated data to be written to enhances devices, the processor linked to the database and, when a descriptor is received, identifying by the accessing the database and determining if enhanced data corresponds to the specific descriptor.

Regarding claim 3, Liff et al. discloses wherein the database includes an order queue including a plurality of orders, each order including a descriptor, the reader including a queue pointer that sequentially identified each of the descriptors in the queue and provides the descriptors to the processor [a user enters a command to request a pharmaceutical package; column 4, lines 54 +].

Regarding claim 5, Liff et al. disclose wherein the data is also a function of a medication user corresponding to the order [58 and 60].

Regarding claim 7, Liff et al. disclose a container source controlled by the processor and providing containers having enhanced devices attached thereto [dispenser 20].

Regarding claim 16, Liff et al. further disclose a label source for providing labels and wherein the printer prints the indicia on the label [printer 54 generates labels 58 according to data outputted by computer].

Regarding claims 21, 28, 34, Liff et al. further disclose that the processor also uses the descriptor to identify human readable indicia to be included on the container wherein the indicia is related to the order, the apparatus further including a label source

and an indicia printer linked to the processor, the processor sequencing the indicia printing and data writing such that indicia and data corresponding to the same descriptor are provided on the same container [the bar-code reader verified proper loading and dispensing of the containers; column 6, lines 13 +].

Regarding claim 25, Liff et al. disclose a container source [20] wherein the source provides containers with attached descriptors.

Regarding claim 29, Liff et al. discloses wherein the container is a medical container [pharmaceutical package] including prescription information 59].

Regarding claim 32, Liff et al. disclose a hand-held scanner unit [41].

Regarding claim 33, Liff et al. disclose wherein the scanning device [40, 41] is capable of writing data through the keyboard wedge [64] to an enhanced device [column 6, line 13+].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al.

Regarding claims 22-24, Liff et al. disclose the claimed invention except for the specific claimed steps of the printing and/or writing sequences.

The examiner takes official notice that it is known to have printers with different printing sequences and speeds. Lacking a showing of criticality these features are held to not patentably distinguish them over the prior art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have a specific printing/writing device to perform according to desired sequencing.

Claims 6, 8-15, 17-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al. in view of Foote et al. [US 6,036,231].

Regarding claims 6, 8-10, 13, 14, 17-19, Liff et al. disclose that the label is attached to the container(s) except for the descriptor including an enhance and non-enhanced source/device.

Foote disclose a pharmacy label and record system wherein the labels are adhesive and comprise the functionality of an enhance and a non-enhanced source/device [column2, lines 9-10].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to the labeling system of Foote with Liff et al. to facilitate specified instructions.

Regarding claims 11, 20, Liff et al., as modified, disclose wherein the printers [56 and 54] produced indicia on documents [58 and 60].

Regarding claims 12, 15, Liff et al., as modified, disclose the claimed invention. Liff et al. further disclose a label source for providing labels and wherein the printer prints the indicia on the label [printer 54 generates labels 58 according to data outputted by computer].

***Response to Arguments***

Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

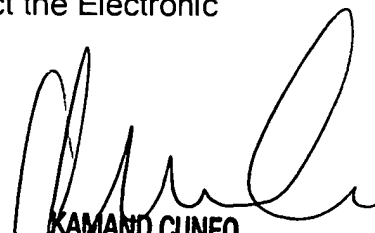
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Raistrick et al. [US 6,877,658] ; Rubin [US 4,476,381] ; Sleep et al. [US 6,317,648].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S. Phan whose telephone number is 571-272-2109. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tsp

  
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